

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/843,771

AMENDMENTS TO THE DRAWINGS

Applicants are enclosing herewith one (1) sheet of replacement drawings, which includes FIG. 2. FIG. 2 has been amended to refer to the IVR 26. The submitted drawing is intended to replace FIG. 2 as originally filed on April 30, 2001.

Attachment: One (1) Replacement Sheet

REMARKS

As an initial matter, Applicant thanks the Examiner and supervisor for the courtesies extended to Applicant's representative during the personal interview on March 1, 2005, in which the rejections under 35 U.S.C. § 112 and 103 were discussed. Applicant has amended the claims taking into account this discussion.

Claims 6-9 and 11-15 are all the claims pending in the application. Claims 6, 7, 9, 12, 13, 15, and 22 are independent claims. Claims 22-24 have been canceled.

Drawing and Claim Objections

As an initial matter, Applicant has enclosed one Replacement Sheet in which Fig. 2 has been amended to show the Interactive Voice Response "IVR" Interface 26. In view of amended Fig. 2, Applicant respectfully requests that the Examiner withdraw the drawing objection.

The Examiner has objected to claim 14, alleging that there is insufficient antecedent basis for the phrase "textual format message." Therefore, Applicant has amended claim 14 to instead recite --non-voice format message--. In view of this amendment, Applicant respectfully requests that the Examiner withdraw the claim objection.

Claim Rejections Under 35 U.S.C. § 112

Second Paragraph

Claims 6, 7, 9, and 24 are rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. Claim 24 has been canceled, rendering the rejection of this claim moot.

With respect to claim 6, the Examiner alleges that it is unclear whether the recitation “said message” in lines 5 and 6 refers to the voice message or the SMS message. Accordingly, Applicant has removed this recitation from claim 6.

In addition, the Examiner seems to indicate that the use of both the recitation “text” and the recitation “text message” is confusing. Accordingly, Applicant has used the phrase “converted text” to refer to the text that has been converted from the voice message, while maintaining the phrase “text message” to refer to a text message that is the combination of the converted text and pre-prepared message.

Similarly, with respect to claim 7, Applicant has used the phrase “converted text message portion” to refer to the text that has been converted from the voice message. With respect to claim 9, Applicant has used the phrase “converted text portion” to refer to the text that has been converted from the voice message.

In view of these amendments, Applicant respectfully requests that the Examiner withdraw the rejections under 35 U.S.C. § 112, second paragraph.

First Paragraph

Claims 7, 9, 12, 13, 15, and 24 are rejected under 35 U.S.C. §112, first paragraph, as allegedly not being described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Claim 24 has been canceled, rendering the rejection of this claim moot.

As an initial matter, it seems, based on the Examiner’s remarks, that the Examiner means to reject these claims based on a perceived deficiency in the written description of the invention

and not a lack of enablement. Accordingly, Applicant has directed the Examiner's attention to the support in the original specification for each of the identified features.

With respect to claims 7, 9, and 12, the Examiner alleges that the phrase "converting said voice message to text message portion" is not disclosed in the specification. However, this feature is discussed with respect to the *non-limiting* embodiment at page 13, lines 13- page 14, line 13 of the original specification. In this embodiment, the called party 12 "may pre-program any number of canned messages, and may specify which messages may be used for which calling party" (14:3-4). The message can also contain a textual section that is not pre-selected. Although this textual section "may alternatively be entered via a conventional telephone keypad" (14:7-8), the system can also enter the textual message "via voice" (14:10).

With respect to claims 13 and 15, the Examiner alleges that the phrase "converting the voice message sent to a non-voice format" is not disclosed in the specification. The Examiner alleges that the non-voice format would be a video format that is not supported by the specification. In fact, the specification discloses a *non-limiting* embodiment of a non-voice format, i.e., the text format. Applicant respectfully submits that the species of a text format provides support for the broader genus of a "non-voice format."

With respect to claim 12, the Examiner alleges that the recitation "said voice message is converted before having entered a voice mail box" is not disclosed in the specification. Accordingly, Applicant has deleted this recitation from claim 12.

In view of the remarks and amendments above, Applicant respectfully requests that the Examiner withdraw the rejections under 35 U.S.C. § 112, first paragraph.

Claim Rejections Under 35 U.S.C. § 103

Claims 6, 9, 11-15, 22 and 24 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Agraharam et al. (US 6,483,899) in view of Parson et al. (US 2002/0085701).

Claims 6-9, 11-15, and 22-24 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Davidson et al. (US 6,775,360) in view of Bannister et al. (US 5,943,399).

Claim 6

With respect to independent claim 6, Applicant respectfully traverses the rejection at least because there is no combination of the applied references that would reasonably teach or suggest all of the claim's recitations. For example, there is no combination of the applied references that would reasonably teach or suggest the claimed system in which an automatic voice recognition server (AVRS) converts a voice message to converted text, a call answering service (CAS) provides a text message including a pre-prepared message and the converted text, in which the pre-prepared message is selected from a plurality of available pre-prepared messages that are pre-programmed by a called party.

With respect to the combination of Agraharam and Parsons, Agraharam discloses a voice messaging system in which a network 120 converts a voice message to a text message. *See* Agraham at 2:28-32. Agraharam, however, does not disclose an interactive voice recognition system in which a pre-prepared message is selected from a plurality of available pre-prepared messages or that a call answering service provides a text message that includes both the pre-prepared message and a converted text message portion (converted from a voice message).

Parson discloses an interactive voice response system in which a caller "can leave a text message for the user." The incoming caller selects from predetermined messages that "can be

appended with numeric information.” *See* Parsons at para. 90. However, Parsons does not disclose that the text message includes both the pre-prepared message and a converted text message portion that is converted from a voice message. Instead, *numeric information* (which can be entered through a keypad) is added to the predetermined messages.

The Examiner asserts that it would have been obvious to modify Agraharam to have called party pre-programmed messages. However, the Examiner has not identified *objective evidence* of any motivation or suggestion in either Agraharam or Parsons to modify Agraharam’s voice messaging system so that a text message includes both a pre-prepared message and a converted text message portion that is converted from a voice message.¹ Instead, Parsons merely pertains to a text message in which numeric information is entered by keypad because “callers almost universally will be able to enter numbers via a phone keypad.” *See* Parsons at para. 90. Likewise, Agraharam merely pertains to a text message that is converted from a voice message, but does not discuss modifying the text message to include a pre-prepared message.

With respect to the combination of Davidson and Bannister, Davidson discloses system for providing an e-mail message that includes a text message, which is based on voice data, and

¹ The USPTO is held to a *rigorous* standard when trying to show that an invention would have been obvious in view of the combination of two or more references. *See, In re Sang Su Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), *citing, e.g., In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”). In *Lee*, the Federal Circuit further emphasized that the “need for specificity pervades this authority.” (*Lee* at 1433 (*citing In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”))). The factual inquiry into whether to combine references “must be based on objective evidence of record.” *Lee* at 1433.

voice data as a wave file. *See* Davison at 5:18-53. However, Davidson does not disclose that the text message includes converted text, which has been converted from a voice message.

The background of Bannister discusses a telecommunications network in an interactive voice response (IVR) system in which predefined short messages can be sent by a caller. *See* Bannister at 1:23-30. Moreover, Bannister discloses a telecommunications system in which the calling party can prepare and send to the called party a short text message with several possible answers. *See* Bannister at, for example, 8:20-48. The called party can then respond to the message by pressing a digit on the keypad corresponding to the appropriate answer. *See* Bannister at 8:20-49-63.

The Examiner asserts that it would have been obvious to modify Davidson to have called party pre-programmed messages. However, again the Examiner has not identified *objective evidence* of any motivation or suggestion in either Davidson or Bannister so that a text message includes both a pre-prepared message and a converted text message portion that is converted from a voice message.

In addition, Bannister's messages are not programmed by the called party, but are instead programmed by the calling party, and there is no suggestion to modify Bannister's system so that it is a called part that programs the pre-prepared messages.

Accordingly, Applicant respectfully requests that the Examiner withdraw the §103 rejections of claim 6.

Claims 7-9, 11, and 12

With respect to independent claims 7, and 9, Applicant respectfully traverses the rejection at least because there is no combination of the applied references that would reasonably teach or suggest all of the claims' recitations. For example, there is no combination of the applied references that would reasonably teach or suggest the claimed system or method in which a voice message is converted to text, and a text message has both a pre-prepared message and the converted text, in which the pre-prepared message is selected from a plurality of available pre-prepared messages that are pre-programmed by a called party. These distinctions are discussed above with respect to independent claim 6.

Moreover, Applicant respectfully requests that the Examiner withdraw the rejection of dependent claims 8 and 11 at least because of their dependency from claims 7 and 9, respectively.

Claims 13-15

With respect to independent claim 15, Applicant respectfully traverses the rejection at least because there is no combination of the applied references that would reasonably teach or suggest all of the claims' recitations. For example, there is no combination of the applied references that would reasonably teach or suggest the claimed system or method in which a voice message is converted to a non-voice format, and a non-voice message has both a pre-prepared message and the converted non-voice message, in which the pre-prepared message is selected from a plurality of available pre-prepared messages that are pre-programmed by a called party.

The deficiencies in the prior art are discussed above with respect to independent claim 6 with respect to a voice message converted to a text format. The same deficiencies apply to

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independent claims 13 and 15 because there is no suggestion that the system includes a non-voice message that has both a pre-prepared message and the converted non-voice message.

Moreover, Applicant respectfully requests that the Examiner withdraw the rejection of dependent claim 14 at least because of its dependency from claim 13.

Claims 22-24

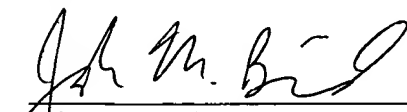
In view of the cancellation of claims 22-24, the rejection of these claims is moot.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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23373
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Date: March 3, 2005